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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,017	01/16/2004	Ilkka Westman	089229.00147	6239
32294 7590 12/12/2007 SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			EXAMINER CHU, WUTCHUNG	
			ART UNIT 2619	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/758,017	Applicant(s) WESTMAN, ILKKA	
	Examiner Wutchung Chu	Art Unit 2619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/16/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/6/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1-6, 8-23, and 25-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Foti et al., hereinafter Foti, (US6917612).

Regarding claim 1, Foti discloses a system and method for address resolution in internet protocol (IP)-based networks (**see col. 3 line 23-45**) comprising:

- obtaining a first address according to a first addressing scheme (**see col. 5 lines 27-28**);
- providing a second address according to a second addressing scheme by including the first address into the second address such that the first address is represented in the second address (**see col. 5 lines 30-36**); and
- providing an indication that part of the second address represents the first address (**see col. 5 lines 30-36**).

Regarding claim 2, Foti teaches further comprising the step of: upon a query on the basis of an address according to the first addressing scheme, returning a corresponding address formed according to the second addressing scheme and the indication that part

of the address according to the second addressing scheme represents the corresponding address according to the first addressing scheme (**see col. 5 lines 30-36**).

Regarding claim 3, Foti teaches further comprising the step of: upon a query on the basis of an address according to the first addressing scheme, returning a corresponding address formed according to the second addressing scheme and adding thereto the indication that part of the address according to the second addressing scheme represents the corresponding address according to the first addressing scheme (**see col. 5 lines 48-58**).

Regarding claim 4, Foti teaches the address returning step is performed by using ENUM translation (**see col. 5 lines 32-36**).

Regarding claim 5, Foti teaches the address returning step is performed by using ENUM translation (**see col. 5 lines 32-36**).

Regarding claim 6, Foti teaches wherein the indication is part of the second address (**see col. 5 lines 52 indication**).

Regarding claim 8, Foti teaches the first address is obtained in an ISUP message (**see col. 7 lines 54-57**).

Regarding claim 9, Foti teaches the second address is a SIP URI (**see col. 3 lines 55-60 and col. 4 lines 3-6**).

Regarding claim 10, Foti teaches further comprising the step of: sending the second address further in a first signaling message (**see col. 5 lines 50-52**).

Regarding claim 11, Foti teaches further comprising the steps of: receiving at least one responding signaling message in response to the first signaling message (**see col. 5 lines 50-52**); and detecting in the received message an indication that the message (**see col. 5 line 52**) includes an address according to the second addressing scheme (**see col. 5 line 30-36**) which includes an address that can be presented according the first addressing scheme (**see col. 5 lines 15-18**).

Regarding claim 12, Foti teaches further comprising the step of: extracting the address according to the first addressing scheme out of the address according to the second addressing scheme (**see col. 5 lines 30-36**).

Regarding claim 13, Foti teaches further comprising the step of: sending the extracted address in a second signaling message (**see col. 5 lines 50-52**).

Regarding claim 14, Foti teaches the first and responding signaling messages are SIP messages (**see col. 5 line 24 SIP invite message**).

Regarding claim 15, Foti teaches the second signaling message is an ISUP message (**see col. 7 lines 54-57**).

Regarding claim 16, Foti teaches the extracted address is an address of a connected user (**see col. 5 lines 20-46**).

Regarding claim 17, Foti teaches the first address is an address according to the E.164 addressing scheme (**see col. 5 lines 33-36**).

Regarding claim 18, Foti teaches the extracted address is an address according to the E.164 addressing scheme (**see col. 5 lines 33-36**).

Regarding claim 19, Foti teaches a network node for implementing interworking of addressing schemes in a communication network using at least two different addressing schemes, the network node (**see col. 3 lines 23-46**) comprising:

- means for obtaining a first address according to a first addressing scheme (**see col. 5 lines 27-28**);
- means for providing a second address according to a second addressing scheme by including the first address into the second address such that the first address is represented in the second address (**see col. 5 lines 30-36**), and for providing an indication that part of the second address represents the first address (**see col. 5 lines 30-36**).

Regarding claim 20, Foti teaches the means for providing a second address comprise:

means for performing a query on the basis of the obtained first address; and means for receiving, upon the query, a corresponding address formed according to the second addressing scheme and the indication that part of the address according to the second

addressing scheme represents the corresponding address according to the first addressing scheme (**see col. 5 lines 30-36**).

Regarding claim 21, Foti teaches the means for providing a second address comprise: means for performing a query on the basis of the obtained first address; and: means for receiving, upon the query, a corresponding address formed according to the second addressing scheme; and means for adding to the returned address the indication that part of the address according to the second addressing scheme represents the corresponding address according to the first addressing scheme (**see col. 5 lines 48-58**).

Regarding claim 22, Foti teaches the means for providing the second address are arranged to provide the second address by using ENUM translation (**see col. 5 lines 32-36**).

Regarding claim 23, Foti teaches the indication is part of the second address (**see col. 5 lines 52 indication**).

Regarding claim 25, Foti teaches the obtaining means is arranged to obtain the first address in an ISUP message (**see col. 7 lines 54-57**).

Regarding claim 26, Foti teaches the second address is a SIP URI (**see col. 3 lines 55-60 and col. 4 lines 3-6**).

Regarding claim 27, Foti teaches the further comprising: means for sending the second address further in a first signaling message (**see col. 5 lines 50-52**).

Regarding claim 28, Foti teaches the further comprising: means for receiving at least one responding signaling message in response to the first signaling message (**see col. 5 lines 50-52**); and means for detecting in the received message an indication that the message (**see col. 5 line 52**) includes an address according to the second addressing scheme (**see col. 5 line 30-36**) which includes an address that can be presented according the first addressing scheme (**see col. 5 lines 15-18**).

Regarding claim 29, Foti teaches the further comprising: means for extracting said address according to the first addressing scheme out of said address according to the second addressing scheme (**see col. 5 lines 30-36**).

Regarding claim 30, Foti teaches the further comprising: means for sending the extracted address in a second signaling message (**see col. 5 lines 50-52**).

Regarding claim 31, Foti teaches the first and responding signaling messages are SIP messages (**see col. 5 line 24 SIP invite message**).

Regarding claim 32, Foti teaches the second signaling message is an ISUP message (**see col. 7 lines 54-57**).

Regarding claim 33, Foti teaches the extracted address is an address of a connected user (**see col. 5 lines 20-46**).

Regarding claim 34, Foti teaches the first address is an address according to the E.164 addressing scheme (**see col. 5 lines 33-36**).

Regarding claim 35, Foti teaches the extracted address is an address according to the E.164 addressing scheme **(see col. 5 lines 33-36)**.

Regarding claim 36, Foti teaches the network node is a MGCF **(see col. 6 lines 18 and figure 2 box 46 MGCF)**.

Regarding claim 37, Foti teaches the network node is acting as at least one of an MGCF **(see col. 6 lines 18 and figure 2 box 46 MGCF)**, a BGCF, an application server **(see col. 5 line 52 location server (LS))**, a multimedia message service center and short message service center.

Regarding claim 38, Foti teaches a communication network **(see col. 3 line 23-46)** comprising at least two subnetworks, at least one network node in each subnetwork, at least one user in each subnetwork and a gateway node interfacing the at least two subnetworks,

- wherein a first subnetwork uses a first addressing scheme routable in the first subnetwork **(see col. 5 lines 27-28)**;
- a second subnetwork uses a second addressing scheme routable in the second subnetwork **(see col. 4 lines 12-35)**; and
- the gateway node **(see col. 4 line 12)** is configured to:
- obtain a first address according to the first addressing scheme **(see col. 5 lines 27-28)**,

- provide a second address according to the second addressing scheme by including the first address into the second address such that the first address is represented in the second address (**see col. 5 lines 30-36**) and
- provide an indication that part of the second address represents the first address (**see col. 5 lines 30-36**).

Regarding claim 39, Foti teaches the gateway node provides the second address using ENUM translation (**see col. 5 lines 32-36**).

Regarding claim 40, Foti teaches further comprising an address translation node (**see col. 5 lines 30-36**), wherein the gateway node is configured to use the address translation node when providing the second address (**see col. 5 lines 30-36 and lines 48-58**).

Regarding claim 41, Foti teaches the address translation node is configured to perform the address translation using ENUM translation (**see col. 5 lines 32-36**).

Regarding claim 42, Foti teaches the gateway node is further configured to receive the first address in a signaling message from the first subnetwork (**see col. 5 lines 48-58**).

Regarding claim 43, Foti teaches the gateway node is further configured to send the second address in a signaling message to the second subnetwork (**see col. 5 line 59 – col. 6 line 20**).

Regarding claim 44, Foti teaches a user of the second subnetwork is configured to send, in response to a received initiating signaling message, the connected address in a response signaling message (**see col. 5 lines 20-52**).

Regarding claim 45, Foti teaches a network node of the second subnetwork is configured to control a user of the second subnetwork, an to send, in response to a received initiating signaling message to the user, the address of the user in a response signaling message (**see col. 5 line 30-36 and 50-52**).

Regarding claim 46, Foti teaches the gateway node is further configured to receive a signaling message from the second subnetwork and to detect in the received message an indication that the message includes an address according to the second addressing scheme which includes an address that can be presented according the first addressing scheme (**see col. 5 lines 48-58**).

Regarding claim 47, Foti teaches the gateway node is further configured to extract the address according to the first addressing scheme out of said address according to the second addressing scheme (**see col. 5 lines 30-36**).

Regarding claim 48, Foti teaches the gateway node is further configured to send the extracted address in a signaling message to the first subnetwork (**see col. 5 lines 50-52**).

Regarding claim 49, Foti teaches the gateway node is a network node of either subnetwork (**see col. 4 line 22**).

Regarding claim 50, Foti teaches the gateway node is a CSCF of either subnetwork (**see col. 5 line 29 CFCS**).

Regarding claim 51, Foti teaches the gateway node is acting as at least one of an MGCF (**see col. 6 lines 18 and figure 2 box 46 MGCF**), a BGCF, an application server (**see col. 5 line 52 location server (LS)**), a multimedia message service center and short message service center.

Claim Rejections - 35 USC § 103

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foti.

Regarding claims 7 and 24, Foti does not explicitly teaches the indication is

`user=phone` tag. However, such limitation is well known in the art and therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to include "user=phone" tag in the system and method for address resolution in internet protocol (IP)-based network of Foti in order to identify the type of user terminals.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takeda et al. (US2003/0225912)

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wutchung Chu whose telephone number is 571 270 1411. The examiner can normally be reached on Monday - Friday 1000 - 1500EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan D. Orgad can be reached on 571 272 7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/WC/
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Edan Orgad